

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:) Attorney Docket No.: F-757
Matthew S. Kissner, et al.) Customer No.: 00919
) Examiner: ALMATRAHI, Faris, A.
Serial No.: 10/707,570) Group Art Unit: 3627
Filed: December 22, 2003)
Confirmation # 1569) Date: April 16, 2010

Title: SYSTEM AND METHOD FOR BILL PAYMENT

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF ON APPEAL

Sir:

The Appellants respectfully submit this reply brief pursuant to 37 C.F.R. § 41.41 in reply to the Examiner's Answer filed on February 18, 2010 in the appeal of the subject application. The Notice of Appeal was transmitted October 16, 2009 and Appellants' Brief on Appeal was transmitted December 16, 2009. Accordingly, this brief is timely filed. No fee is believed due. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. **16-1885**.

I. Examiner's Answer Section 10, Response to Arguments

"Argument B"

On page 7 of the Answer, with regard to claim 1, the Examiner apparently suggests that the term "digital paper bill" does not require that is a printed physical digital paper bill. However, one of ordinary skill in the art having read the specification would only interpret claim 1 as representing a printed digital paper bill. See Appellants' Brief at page 4.

Accordingly, Appellants' respectfully submit that the rejection is based upon a clearly erroneous claim interpretation and should be reversed.

"Argument C"

On page 8 of the Answer, with regard to claim 4, the Examiner apparently suggests that a cited reference "implicitly" reads on the claim. However, to properly rely on an inherency argument to supplement the deficiencies of the explicit teaching of the reference, the Examiner must show that inclusion of that exact element must be the only possibility. It is not sufficient that the allegedly inherent characteristic may occur or be present in the prior art. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); MPEP 2112, section IV.

Accordingly, the rejection is based upon at least an improper inherency reliance and should be reversed.

"Argument D"

On page 8 of the Answer, with regard to claim 5, the Examiner apparently suggests that the cited reference discloses receiving a payment processed notice. However, the citation to page 5 apparently deals with receiving coordinate information

and has nothing to do with payment processed noticed. Additionally, the citation to page 21 apparently deals with loading data regarding types of payments possible. Finally, the citation to page 24 apparently deals only with receiving back a network address of a computer and does not disclose receiving a payment processed notice.

“Argument E”

On pages 8-10 of the Answer, with regard to claims 6-7, the Examiner incorrectly suggests that the reliance on “official notice” is proper. If the rejection has been changed, it should be presented as a new ground.

As shown in MPEP section 2144.03(c) quoted in the Answer, and more importantly the underlying case quotations, it is clear that Appellants’ need not and could not prove that some piece of information is not old and well known. Appellants’ are only required to traverse the statements of Official Notice as Appellants have repeatedly in this case. The traversal was timely and adequate.

Appellants again dispute any such statement unless expressly admitted herein. In relying on Official Notice, the MPEP instructs that only “notorious” facts used to “fill the gaps” in dependent claims is appropriate and its use should be rare at final rejection or later. See MPEP 2144.03. Contrary to the Examiner’s suggestion, this is not a case in which Appellants have never challenged the statements of Official Notice. With regard to claim 6, Appellants do not dispute that sending a receipt for payment was known, but dispute any broader notice and dispute the combination put forth by the Examiner. With regard to claim 7, Appellants do not dispute that using XML formatted data was known, but dispute any broader notice and dispute the combination put forth by the Examiner.

“Argument F”

On page 10 of the Answer, with regard to claim 9, the Examiner apparently suggests that a cited reference “implicitly” reads on the claim. For the same reasons described above with reference to Argument C, the Appellants respectfully submit that

the rejection is based upon an improper inherency argument and should therefore be reversed.

“Argument G”

On page 10 of the Answer, with regard to claim 12, the Examiner apparently suggests that the claim does not recite a hand-written amount.

Claim 12 is reproduced below and recites an indication of a pen used to write a payment amount.

12. The method of claim 2, wherein,
the payment request includes an indication that the consumer used the digital pen to write a payment amount in an digital pen pattern box.

Accordingly, Appellants respectfully submit that the rejection is in error and should be reversed.

“Argument H”

On page 11 of the Answer, apparently with regard to claims 13 and 23-24, the Examiner apparently suggests that the term “the invoice in question” suggests a payment dispute. However, the paragraph of the reference is reproduced below to show that no fair reading of the language suggests a dispute of any kind, but rather is used to identify a particular invoice.

The company X also informs (arrow from 400 to 408) the giro bank’s computer 408 that the invoice in question, that has a particular number, has been provided with a subset of the position-coding pattern which codes coordinates within a particular sub-area. The giro bank stores this information in a database in its computer 408.

(emphasis added). See Wiebe ‘387, page 24, lines 5-11.

Accordingly, Appellants respectfully submit that the rejection is in error and should be reversed.

Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-13 and 21-24 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted on behalf of Appellants,
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